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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,625	10/23/2003	Michel Therin	1600-25 (BR040489)	5931
Peter DeLuca Carter, DeLuca, Farrell & Schmidt, LLP 445 Broad Hollow Road, Suite 420 Melville, NY 11747			EXAMINER TYSON, MELANIE RUANO	
			ART UNIT	PAPER NUMBER
			3773	
			MAIL DATE	DELIVERY MODE
			10/08/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,625

Applicant(s)

THERIN ET AL.

Examiner

MELANIE TYSON

Art Unit

3773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,14,15 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,14,15, and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-506)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 August 2010 has been entered. Claims 2, 7, 12, 13, and 16-18 are cancelled. Claims 19-23 remain withdrawn from consideration. New claim 24 has been added.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-6, 8-11, 14, 15, and 24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-6, 8-10, 14, 15, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt (U.S. Patent No. 6,042,592) in view of Plouhar et al. (U.S. Patent No. 6,638,312 B2) and Scetbon (U.S. Patent No. 6,406,423 B1).

Schmitt discloses a composite prosthesis for reinforcement of a tissue structure (see entire document) comprising a porous textile support that includes an arrangement of threads each composed of filaments of non-absorbable polymer material (polyester) forming a three-dimensional knitted structure, and a non-continuous film enveloping and penetrating into the arrangement of threads, occluding the microporous structure (for example, see column 5, lines 55-65), but not the macroporous texture (52; for example, see column 6, lines 57-63). Schmitt fails to disclose a portion of the macroporous texture is occluded.

Plouhar discloses a composite prosthesis comprising a textile support (322) defining a macroporous structure (spaces between threads). Plouhar teaches the textile support may be partially coated, such that portions of the macroporous texture are occluded and portions remain not occluded, in order to increase the strength of the occluded portions of the textile support (for example, see column 6, lines 16-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to occlude some portions of Schmitt's macroporous texture with the film as taught by Plouhar in order to increase the strength of the textile support in such portions as desired. Schmitt also discloses the film may be a polymeric material, but fails to disclose specifically that the film is hydrophilic absorbable material.

Scetbon discloses a prosthesis for reinforcement of a tissue structure comprising a film (see entire document). Scetbon teaches the film is hydrophilic and absorbable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Schmitt's film of a hydrophilic absorbable material as taught by Scetbon. Doing so would reduce erosion and sclerosis of supported tissue to a minimum (for example, see column 4, lines 3-5).

With further respect to claims 4 and 5, Schmitt's film encapsulates the prosthesis which is disclosed as being 0.05 mm - 0.5 mm, thus the film has a thickness of about 0.05mm - 0.5mm. To modify the thickness of the prosthesis such that the film has a thickness of less than or equal to 500 microns, or from 10-100 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With further respect to claims 8-10, Schmitt in view of Scetbon discloses the textile support is rectangular with parallel edges (for example, see Figure 7), but fails to disclose the shape recited in claim 10. The applicant has not disclosed that a strip with curved edges provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with straight edges because the function of the prosthesis is to act as a reinforcement for tissue structures and this function is not affected by its shape. Therefore, it would have been obvious to modify Schmitt's in view of Scetbon prosthesis to obtain the invention recited in claim 10.

With further respect to claim 14, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the absorbable material from the group formed by collagens, polysaccharides, and their mixtures, since it has been held to be within the general skill of a worker to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt in view of Plouhar and Scetbon as applied to claim 1 above, and further in view of Landgrebe et al. (EP 0774240 A1).

Schmitt in view of Plouhar and Scetbon discloses the claimed invention except for a prosthesis having nonparallel edges and a bulged central region. Landgrebe et al. disclose a strip (Figure 1, not labeled) having nonparallel edges (top edge 2 and bottom edge not labeled). Figure 1 shows the device is bulged in the central region (1) and narrower at the ends (5, 6, 7, and 8). This configuration allows the device to support a wide surface area of an organ (bladder; column 1, lines 45-47), thus contributing to a reliable treatment of incontinence in cases of extreme weakness of the pelvic floor with prolapsing anatomical displacement of the organs of the lesser pelvis (column 1, lines 33-39). Therefore, to construct Schmitt's prosthesis, as modified by Plouhar and Scetbon, having nonparallel edges and a bulge as taught by Landgrebe et al. would have been obvious to one of ordinary skill in the art at the time the invention was made in order to support prolapsed structures on a large surface area.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571) 272-9062 and e-mail address is Melanie.tyson@uspto.gov. The examiner can normally be reached on Monday through Thursday 8-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
October 5, 2010